UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE.	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,564	12/18/2000	John M. Hibscher	03405.018001	6450

25541   7590   01/28/2005

NEAL, GERBER, & EISENBERG
SUITE 2200
2 NORTH LASALLE STREET
CHICAGO, IL 60602

EXAMINER
HOTALING, JOHN M

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _27 September 2004_.

2a)☒ This action is **FINAL**.　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _14-32_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _14-32_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-15, 17-18, 20-22, 24, 26, 29-30, 32 are rejected under 35 U.S.C. 103(a) as

being unpatentable over US Patent No. 6,102,796 to Pajitnov et al. (Hereafter, Paj) in

view of US Patent No. 5,599,231 to Hibino et al. (Hereafter, Hibino) in view of US 6,

117,061 to Popat et al (Hereafter, Popat). Paj teaches on-line gaming played over

networks such as the Internet and the World Wide Web (2:9-13). The primary gaming

method and system is directed to a puzzle game (2:34-49). The game is played by

downloading configuration, control modules, and game data from a remote server (4:25-

29) to a gaming terminal. The game has further interaction with the server by uploading

game data and processed by the server and in turn the server will provide a score to be

downloaded by the computer gaming terminal (4:64-67). Downloaded control modules

include code, applets, routine, programs, components, objects to implement the network

game (8:41-44). These control modules serve to define HTML and application service

script modules. As the remote computer has software/game data to download, the

remote computer has game storage. Paj teaches the online game played over the

internet, but does not teach linking a user identifier to game access or the ability to

create, edit or play games. Hibino teaches a user's ability to create, edit, and play

multiple games tied to levels of authorized user access (4:4-16)., and that the game

system can be configured in an on-line network configuration (4:38-40). Hibino further

teaches that game information can be sent to a remote storage sever to provide further

network access to other people, using this network embodiment in place of local floppy

disk based storage solution (13:24-37). Lastly Hibino teaches that access to remote

games is controlled by use identification (21:15-38). One would be motivated to modify

Paj to include game editing and creation taught by Hibino so that one could create a

game that would meet the necessary requirements of being quickly and easily solvable.

Paj states that creating a balanced difficulty puzzle game is the key to keeping users

interested in the game (2: 1-18), therefore obvious to one of ordinary skill to give a user

the ability to create and edit puzzle game, which allows a user to customize the level-of

difficulty involved to solve the puzzle. Paj in view of Hibino teaches a system that

utilizes network connectivity, but do not provide game software as executable on a

server. Popat is generally related to software for creating custom puzzles and other

implements (Abstract and 2:52-60). Popat covers that the system operation may be in a

local user mode, wherein a user designs and executes the software on a local machine

(1:53-67).Popat also details that the software execution location is not dependent on

local machine and can be executed remotely though a computer network over the

Internet (6:35-45). The motivation to use such a remote system is evident in thin-client

software design and dumb terminal as is known in the art. Such system designs remove

the burden of managing hardware and software updates by keeping such management

resigned to a central location. Thus it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify Paj in view of Hibino to use the

remotely accessed software to keep management costs to a minimum.

Claims 16, 23, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Paj in view of Hibino in view of Popat as applied to claims 14-15, 17-18, 20-22, 24, 26,

29-30, 32 above, and further in view of US Patent No. 6,386,543 to Luker. Paj in view

of Hibino in view of Popat discloses the claimed limitations as discussed above, but

does not provide the on-line puzzle game to be a crossword puzzle. Luker teaches the

ability to create, edit, solve, and store crossword puzzles over the Internet or applying

such techniques using various other media storage known in the art (3:57-4:4). One

would be motivated to modify Paj in view of Hibino in view of Popat to use the

crossword puzzle taught by Luker as word games are a very prominent form of

entertainment with a numerous game player base. Furthermore, the system taught by

Paj is not limiting in the type of game that can be applied in an on-line context.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to include crossword puzzles as a game choice because wide

spread game acceptance ensures game popularity.

Claims 19, 25, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Paj in view of Hibino in view of Popat as applied to claims 14-15, 17-18, 20-22, 24, 26,

29-30, 32 above, and further in view of Applicant's admissions of prior art (Hereafter,

App). Paj in view of Hibino in view of Popat discloses the claimed limitations as

discussed above, but does not provide detail of well-known applications and uses of web-based technology. App teaches various application and uses of web-based technology that are disclosed as old and well known in the art. App teaches that initially puzzles were provided by static HTTP methods (2:16-2%. Then as the technology improved, various programming languages and modules were added such as JAVA and ShockWave to provide dynamic delivery of puzzles to users over the Internet Reb (3: 1 1-4:21). Shockwave and JAVA can be embedded modules in both the server and client side web browser applications, which can then provide dynamic content and movies. By no means do these languages and modules provide the only means to dynamic interactivity on the Internet/Web, but merely a small number of a multitude of available technologies disclosed by App. One would be motivated to combine features of Paj in view of Hibino in view of Popat and App as both teach Internet available puzzle games that can constructed and played by users and modifying Paj in view of Hibino in view of Popat to include teachings of App would serve to further define what technologies could be used for the Paj in view of Hibino in view of Popat system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Paj in view of Hibino in view of Popat to include the various implementation technologies taught by App to increase puzzle application usability, where employing the various implementation technologies would serve to increase operating system (OS) platform diversity as some technologies are only available on certain OS platforms. The use of the Shockwave as a module serves to define the use of a movie/multimedia module.

Response to Arguments

Applicant's arguments filed 9/27/04 have been fully considered but they are not persuasive.

With respect to the applicant's representatives brief descriptions of the references the examiner notes that the rejection is based on a combination of the teachings of the references and not based on what one reference teaches.

With respect to the statement that "Hibino does not teach the use of the Internet as a medium from which game creating and editing is to occur" It is noted that the internet by itself cannot do or be a medium for accomplishing what the applicant is stating. Hibino does stat that the Internet is the medium for transferring information for game creation and editing as noted in the rejection above. Game creation and edition is done in the processor of the computer.

With respect to the applicant's statement that the references of Popat and Hibino teach away from the present invention the examiner asters that the rejection is based on a combination of references and that both of the reference to Hibino and Popat teach the use of a computer system.

With respect to online creation of puzzles please see the rejection above. In addition if one is to play and edit a puzzle online it follows that an instance of the puzzle must also be created online.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Citation of pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 form is related to online creation of game instances including puzzle games, player identification and puzzle tournaments.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
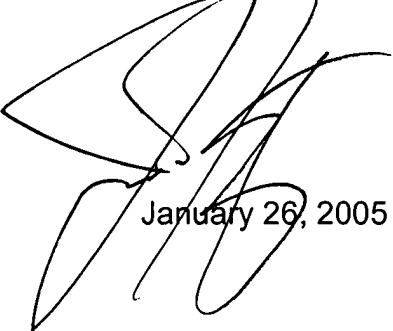
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is (571) 272 4437. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Xuan Thai can be reached on (571) 272 3507. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. HOTALING, II
PRIMARY EXAMINER

January 26, 2005